Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. FELD

Appeal No. 1999-2783
Application No. 08/654,034

ON BRIEF

Before ABRAMS, FRANKFORT, and GONZALES, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 11, which are all of the claims pending in this application.

Appellant's invention is directed to a floating artificial weed line for attracting fish. As noted on page 2 of the specification, the artificial weed line is designed to

imitate floating sea weed. The weed line attracts fish because it provides a source of shade and shelter or protection, and will be perceived by fish as providing a potential source of food. As can be seen in the drawings of the application, the weed line is formed of a light-weight, floating frame (4) made from any buoyant material and defining a relatively large central aperture. The large central aperture of the frame is covered with a thin sheet of water resilient plastic or vinyl (2) that is made to simulate sea weed and provide shade to fish. In contrast to the prior art described on page 1 of the specification, which is bottom anchored and fully submerged, the present invention is designed to provide a floating artificial fish attracting habitat that floats on the surface of a body of water and imitate floating sea weed as it drifts on the water surface. Independent claims 1, 10 and 11 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bromley	3,540,415	Nov. 17, 1970
Budge et al. (Budge)	3,638,615	Feb. 1, 1972
Hill	4,876,817	Oct. 31, 1989
Fussell	5,315,779	May 31, 1994

Claims 1 through 7, 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fussell in view of Budge and Hill.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fussell, Budge and Hill as applied to claim 1 above, and further in view of Bromley.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fussell in view of Hill.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the examiner's answer (Paper No. 13, mailed February 17, 1999) for the

reasoning in support of the rejections, and to appellant's brief (Paper No. 12, filed January 7, 1999) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Preliminary to discussing the rejections on appeal, we note that on page 8 of the brief appellant has indicated that claims 1 through 7 and 9 can be grouped together, while claim 10 should be considered separately. Claims 8 and 11, not mentioned on page 8 of the brief, are argued separately on pages 14 and 15 of the brief.

Looking first at the examiner's rejection of claims 1 through 7, 9 and 10 under 35 U.S.C. § 103(a) based on the

collective teachings Fussell, Budge and Hill, we note that Fussell was one of the prior art patents discussed by appellant on page 1 of the specification and was distinguished from appellant's floating artificial weed line because the structure in Fussell is a bottom anchored, fully submerged fish attracting structure, while appellant's floating artificial fish attracting habitat or weed line drifts on the surface of a body of water and simulates floating sea weed by blocking at least a portion of the sun's rays. Budge is directed to an apparatus for growing oysters in sea water. Figure 6 of Budge shows a wooden framework (42) carrying floats (47) which ensure that the framework floats adjacent the surface (48) of the sea or ocean (49). As indicated in column 5, lines 8-12, a plurality of wires (51) are mounted to the framework in such a manner that they are positioned a substantial distance below the surface (48) of the sea or ocean so that they will not be uncovered by the normal wave action of the sea or ocean. These wires carry screens (22) which have seed oysters (26) attached thereto. The seed oysters are intended to remain covered by the sea water and to grow to maturity while being supported by the apparatus of

Budge. Hill discloses an archery bow-mounted blind that includes a camouflage sheet (16) of vinyl material and a support structure (18). The sheet (16) has a plurality of chevron-shaped cuts (20) therethrough forming a corresponding number of flaps (22) which simulate foliage and provide openings which allow clear observation by an archer using the bow to which the blind is mounted.

In the examiner's view, Fussell discloses a floating device comprising a plurality of floating discs (15, 16, 17), each having at least one aperture (20) therein. The examiner concedes that Fussell fails to disclose a) a blocking means attached to the floating pieces for blocking at least a portion of the sun’s rays, b) a buoyant framework as set forth in claims 1 through 5 on appeal, and c) material connected to a planar rectangular framework and covering the at least one large opening therein, wherein the material has a plurality of apertures for allowing a predetermined portion of the sun's rays through the said at least one opening.

To provide for these differences between Fussell and the claimed subject matter, the examiner urges that it would have been obvious to one of ordinary skill in the art at the time appellant's invention was made to

> provide the floating piece of Fussell with a blocking means attached to the rectangular floating piece in view of Budge et al and Hill so as to maintain the floating piece in horizontal level when the floating piece is anchored to a bottom of a body of water (answer, page 4).

In addition, the examiner also concludes that it would have been obvious to one of ordinary skill in the art to

> provide the floating piece of Fussell with a water resilient plastic material made of vinyl in view of Hill so as to provide shelter to the school of fish and block a substantial amount of sun rays from penetrating the floating piece line when anchored to a bottom of a body of water (answer, page 4).

Appellant asserts that the Hill reference is non-analogous art because it is not within appellant's field of endeavor (i.e., floating artificial weed lines) and is not reasonably pertinent to the particular problem that appellant addresses. Moreover, appellant urges that the examiner has utilized the Hill reference from a totally unrelated art based

only on appellant's suggestion concerning the type of sheet material involved in the floating artificial weed line of the present application, and thus relied upon hindsight gained from appellant's own application in citing the Hill patent. Appellant also argues that the examiner's positions on obviousness in this appeal represent a classic case of the examiner using impermissible hindsight in order to reconstruct appellant's claimed subject matter.

Considering the question of non-analogous prior art, for resolution of obviousness under 35 U.S.C. § 103 the law presumes full knowledge by the hypothetical worker having ordinary skill in the art of all the prior art in the inventor's field of endeavor. With regard to prior art outside the inventor's field of endeavor, knowledge is presumed only as to those arts reasonably pertinent to the particular problem with which the inventor was involved. See In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992), In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) and In re Antle, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971).

Thus, the determination that a reference is from a nonanalogous art is twofold. First, it must be decided if the reference is from within the inventor's field of endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was concerned. In the present case, like appellant, we are of the view that the archery bow mounted hunting blind of the Hill patent is non-analogous prior art because it is not within appellant's field of endeavor and is not reasonably pertinent to appellant's particular problem of providing a floating artificial fish attracting habitat (i.e., a floating artificial weed line).

The examiner's position (answer, page 10) that Hill is analogous prior art because it is reasonably pertinent to the particular problem with which the applicant was concerned "because Hill discloses a concept of a plastic material made from a vinyl sheet," evidences an apparent lack of understanding on the examiner's part as to the particular problem confronted by appellant and provides no basis whatsoever for concluding why a reference that addresses a

hunting blind structure mounted on an archery bow would have logically commended itself to the inventor's attention in dealing with his particular problem of a floating artificial fish attracting habitat (i.e., a floating artificial weed line) designed to float at the surface of a body of water.

Moreover, even if we were to assume for argument sake that Hill was analogous prior art, we share appellant's view that there is no motivation or suggestion in the applied references which would have reasonably led one of ordinary skill in the art to the examiner's proposed combination of Fussell, Budge and Hill. Like appellant, it is our view that the examiner has used impermissible hindsight derived from appellant's own teachings to combine the totally disparate subject matter of the submerged fish habitat of Fussell, the apparatus for growing oysters of Budge and the archery bow mounted hunting blind of Hill in an effort to arrive at appellant's claimed floating artificial weed line. In this regard, we note that, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266 n. 14, 23 USPQ2d 1780, 1783-84 n. 14 (Fed. Cir. 1992), it is impermissible to use the claimed

invention as an instruction manual or "template" to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. That same Court has also cautioned against focussing on the obviousness of the differences between the claimed invention and the prior art rather than on the invention as a whole as 35 U.S.C. § 103 requires, as we believe the examiner has done in the present case. See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1375, 231 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

Since we have determined that Hill is non-analogous prior art and also that the teachings and suggestions found in Fussell, Budge and Hill would not have made the subject matter as a whole of claims 1 through 7, 9 and 10 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a).

As for the examiner's rejection of dependent claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Fussell,

Budge and Hill as applied to claim 1 above, and further in view of Bromley, we have reviewed the Bromley patent, but find nothing therein which provides for or overcomes that which we have found lacking in the examiner's basis combination of Fussell, Budge and Hill. Accordingly, the examiner's rejection of dependent claim 8 under 35 U.S.C. § 103(a) also will not be sustained.

The last of the examiner's rejections for our review is that of claim 11 under 35 U.S.C. § 103(a) based on the collective teachings of Fussell and Hill. Again, for the reasons stated above, we consider that Hill is non-analogous prior art and would not have reasonably commended itself to the appellant's attention given the particular problem he was confronting. Moreover, like appellant, we also consider that the examiner has relied upon impermissible hindsight in attempting to combine the disparate teachings of Fussell and Hill so as to arrive at appellant's claimed floating artificial weed line. Thus, the examiner's rejection of claim 11 under 35 U.S.C. § 103(a) will not be sustained.

In light of the foregoing, the decision of the examiner to reject claims 1 through 11 under 35 U.S.C. § 103(a) is reversed.

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against claim 11 on appeal.

Claim 11 is rejected under 35 U.S.C. § 102(b) as being anticipated by the floating raft seen in Figures 6 and 7 of the Budge patent. Figures 6 and 7 of the Budge patent show a floating raft comprising a wooden framework (42) formed of members (43, 44) fastened together and including floats (47) to provide added buoyancy. The wooden members (43, 44) define a planar buoyant structure or, in the terms of appellant's claim 11, comprise substantially planar buoyant material that not only "resembles organic matter" as the claim sets forth, but actually is organic matter (i.e., wood) and which has a specific gravity to float substantially horizontally at the surface of a body of water (e.g., salt water). The framework clearly blocks a portion of the sun's rays when it is floating on the surface of a body of water thereby providing shade and

shelter or protection for fish. Appellant's own specification (page 1) establishes that fisherman know that fish congregate around and under floating objects. Accordingly, we consider that the floating wooden framework of Budge would have been viewed by one of ordinary skill in the art as a floating artificial fish attracting habitat and, more specifically, as broadly being a floating artificial weed line that "imitates" floating sea weed or other flotsam for attracting fresh or salt water fish. In this regard, we point to the bottom of page 4 of appellant's specification, and the indication therein that the invention is not intended to be limited to the look of sea weed attached to a frame, and that the invention is intended to cover "alternate embodiments using material that does not resemble sea weed."

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR

§ 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner . . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

NEAL E. ABRAMS)
Administrative Patent Judge)

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REVERSED; 37 CFR 1.196(b)

Prepared: September 25, 2001